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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,667	07/02/2003	Richard L. Beard	600-33-DIV	3474

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EXAMINER

MCKENZIE, THOMAS C

ART UNIT	PAPER NUMBER
1624	

1624

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N . 10/612,667	Applicant(s) BEARD ET AL.	
	Examiner Thomas McKenzie, Ph.D.	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Peri d f r R ply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 October 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10, 14, 15 and 28-33 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 10, 14, 15 and 28-33 is/are allowed.
- 6) Claim(s) 1-3 and 8 is/are rejected.
- 7) Claim(s) 4-7 and 9 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Pri rity under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/8/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to an election filed on 10/18/04. There are eighteen claims pending and eighteen claims under consideration. Claims 1-10, 14, 15, and 28-33 are compound claims. The application concerns some dihydronaphthylene compounds.

Election/Restrictions

2. Applicant's election with traverse of Group I in the reply filed on 10/18/04 is acknowledged. The traversal is on the ground(s) that no search burden is present. This is not found persuasive because according to MPEP §803 "For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant." Applicants pointed to no errors in the Examiners analysis of the classification of the different inventions. The requirement is still deemed proper and is therefore made FINAL.

3. Objection is made to claims 1-9 as containing non-elected subject matter. The claimed compounds, compositions, and methods that employ them present a variable core. Formula of claim 1 contains compounds drawn to the non-elected

inventions to the extent it reads upon compounds other than those where Y is pyridyl.

Title

4. The title of the invention is no longer descriptive after the restriction. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: replacement of the phrase "an Aryl or Heteroaryl" by "Pyridyl".

Priority

5. The status of non-provisional parent application should also be included. Since the parent application has become a patent, please add the expression "now Patent No. 6,613,917" following the filing date of the parent application in the first line of the specification.

Claim Objections

6. Claim 1 is objected to because of the following informalities: in line 17, page 115 the word "benzyloxy" has been misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 102

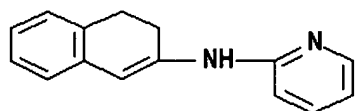
7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1624

Claims 1-3, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Huisgen (Tetrahedron Letters). The compound shown below fits the formula of claim 1 with $X = C(R)_2$, $R = R_1 = R_2 = B = H$, $m = o = q = 0$, and $Y = 2\text{-pyridyl}$. It has Registry Number 23951-70-4 and is found in the figure on page 2592 of the reference. It is compound 20b and its synthesis is described on page 2593 in lines 10-11 of Table 3.



Allowable Subject Matter


8. Claims 10, 14, 15, and 28-33 are allowed. Claims 4-7 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. Information regarding the status of an application should be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system,

contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). Please direct general inquiries to the receptionist whose telephone number is (703) 308-1235.

10. Please direct any inquiry concerning this communication or earlier communications from the Examiner to Thomas C McKenzie, Ph. D. whose telephone number is (571) 272-0670. The FAX number for amendments is (571) 273-8300. The PTO presently encourages all applicants to communicate by FAX. The Examiner is available from 9:00am to 5:30pm, Monday through Friday. If attempts to reach the Examiner by telephone are unsuccessful, please contact James O. Wilson, acting SPE of Art Unit 1624, at (571)-272-0661.


Thomas C. McKenzie, Ph.D.
Primary Examiner
Art Unit 1624

TCMcK/me